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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,413	06/24/2004	Rudolf Stelzl	2001P20249WOUS	2287

7590 10/20/2006

Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, NJ 08830

EXAMINER

DOAN, TRANG T

ART UNIT PAPER NUMBER

2131

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/500,413

Applicant(s)

STELZL, RUDOLF

Examiner

Trang Doan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 06/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-7 are canceled. Claims 8-26 are pending.
2. The application is filed on 06/24/2004 but claims the benefit of Foreign Priority has been made and acknowledged. Therefore, the effective filing date for the subject matter defined in the pending claims in this application is 12/27/2001.

Claim Objections

3. Regarding claim 18, "a groups of a subscribers", in line 2, is incorrect. The examiner interprets as "a group of subscribers". Appropriate correction is required.
4. Regarding claim 25, "a data network..", in line 2, is incorrect. The examiner interprets as "a data network.". Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 8-19, 20-22 and 23-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 8-19, 20-22 and 23-26 are not limited to tangible embodiments. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare In re Lowry, 32 F.3d 1579, 1583-84, 32

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USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and Warmerdam, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 8-10, 14 and 17-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Requena (US 2002/0126701) (hereinafter Requena).

9. Regarding claim 8, Requena teaches entering administration data for an administration process (Requena: paragraphs [0235-0239, 0139]: administration data is a Short Message); and converting subsequently the administration data to an SIP-conformant format to execute the administration process (Requena: paragraph [0237]: converting the Short Message into an SIP transaction).

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10. Regarding claim 9, Requena teaches wherein the network is a telecommunication network and /or a data network (Requena: see Abstract section and paragraph [0002]).

11. Regarding claim 10, Requena teaches wherein the method is used for implementing a service based on the presence information (Requena: paragraphs [0002, 0021 and 0026]).

12. Regarding claim 14, Requena teaches wherein the administration data is entered within a predefined short message framework (Requena: paragraphs [0235-0239]).

13. Regarding claim 17, Requena teaches wherein the administration process comprises: updating presence information (Requena: paragraphs [0101 and 0206-0207]).

14. Regarding claim 18, Requena teaches wherein the administration process comprises: defining a group of subscribers who can access the presence information (Requena: see Abstract section and paragraphs [0091, 0128 and 0244-0256]).

15. Regarding claim 19, Requena teaches wherein the administration process comprises: subscribing to presence information of another subscriber or to service based on the presence information (Requena: see figure 1 and paragraphs [0030 and 0063]).

16. Regarding claim 20, this claim has limitations that is similar to those of claim 1, thus it is rejected with the same rationale applied against claim 1 above.

17. Regarding claim 21, this claim has limitation that is similar to those of claim 10, thus it is rejected with the same rationale applied against claim 10 above.

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18. Regarding claim 22, this claim has limitation that is similar to those of claim 9, thus it is rejected with the same rationale applied against claim 9 above.

19. Regarding claim 23, this claim has limitations that is similar to those of claim 1, thus it is rejected with the same rationale applied against claim 1 above.

20. Regarding claim 24, Requena teaches wherein the administration process involves information about a change of the presence status of a prespecified subscriber (Requena: paragraphs [0101 and 0206-0207]).

21. Regarding claim 25, this claim has limitation that is similar to those of claim 9, thus it is rejected with the same rationale applied against claim 9 above.

22. Regarding claim 26, this claim has limitation that is similar to those of claim 10, thus it is rejected with the same rationale applied against claim 10 above.

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claims 11-13 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Requena.

25. Regarding claim 11, Requena shows wherein the administration data is entered within a predefined short message framework. Requena does not expressly show wherein the administration data is entered by voice input and recognition.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The entering step would be performed the same regardless of the administration data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to enter any type of data for an administration process having any type of content. Because such data does not functionally relate to the step in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

26. Regarding claim 12, Requena shows wherein the administration data is entered within a predefined short message framework. Requena does not expressly show wherein entering the administration data is accomplished by keypad entry.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The entering step would be performed the same regardless of the administration data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to enter any type of data for an administration process

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having any type of content. Because such data does not functionally relate to the step in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

27. Regarding claim 13, Requena shows wherein the administration data is entered within a predefined short message framework. Requena does not expressly show wherein entering the administration data is accomplished by voice input and recognition or by keypad entry of a PIN code.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The entering step would be performed the same regardless of the administration data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to enter any type of data for an administration process having any type of content. Because such data does not functionally relate to the step in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

28. Regarding claim 15, Requena shows wherein the administration data is entered within a predefined short message framework. Requena does not expressly show wherein the administration data is entered at an IP-based interface.

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However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The entering step would be performed the same regardless of the administration data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to enter any type of data for an administration process having any type of content. Because such data does not functionally relate to the step in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

29. Regarding claim 16, Requena shows wherein the administration data is entered within a predefined short message framework. Requena does not expressly show wherein the administration data is entered outside a SIP method.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The entering step would be performed the same regardless of the administration data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to enter any type of data for an administration process

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having any type of content. Because such data does not functionally relate to the step in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Conclusion

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Shaughnessy et al. discloses "common services and applications agent" (US 2002/0186684).
- Wang discloses "session initiation protocol user agent in a serving GPRS support node" (US 2002/0131395).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trang Doan whose telephone number is (571) 272-0740. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Trang Doan
Examiner
Art Unit 2131

T.D.
10/11/2006

CHRISTOPHER REVA
PRIMARY EXAMINER

